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APPLICATION NO.	FILING DATE	INVENTOR	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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STEPHEN T. SULLIVAN
5060 NORTH 40TH STREET
SUITE 120
PHOENIX AZ 85018

LM01/1029

EXAMINER
ALVAREZ, R

ART UNIT	PAPER NUMBER
2781	2

DATE MAILED: 10/29/98

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

08/834,240

Applicant(s)

Richard M. Libman

Examiner

RAQUEL ALVAREZ

Group Art Unit

2761



☒ Responsive to communication(s) filed on Apr 15, 1997

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-57 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-57 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

1. Claims 1-57 are presented for examination.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that forms the basis for the rejection under this section made in this office action:

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

3. Claims 1-5, 7, 8, 13, 38-42, 46 and 50-57 are rejected under 35 U.S.C. 102(e) as being anticipated by Reiter (5,819,241 hereinafter Reiter).

With respect to claims 1, 40, 42 and 50, Reiter teaches a method for automatically preparing a client communication for a client, wherein the client communication is for combined use with the corresponding and respective host vehicle. Using decision information to automatically select variable information, the variable information comprising other than the client identification(col 7, lines 33-44, lines 6-10 and col. 8, lines 54-64), and automatically inserting the variable information into the client communication(Figure 1, step 13; Figure 3, step 47).

With respect to claim 2, Reiter further teaches the variable information comprises client information(col. 7, lines 6-10).

With respect to claims 3 and 4, Reiter further teaches the variable information comprises client information other than a client name or a client address(col. 7, lines 6-10).

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With respect to claim 5, Reiter further teaches the variable information comprises client family information(col. 13, lines 46-47).

With respect to claim 7, Reiter further teaches the variable information comprises client geographic information other than the client address information(col. 12, lines 24-26 and col. 13, lines 46-47).

With respect to claim 8, Reiter further teaches the variable information comprises client purchasing information(col. 7, lines 11-20).

With respect to claim 13, Reiter further teaches the variable information comprises client occupation information(col. 12, lines 26-28).

With respect to claims 38, Reiter further teaches the variable information comprises a text(col. 15, lines 66-, col. 16, lines 1-2).

With respect to claims 39 and 41, Reiter further teaches combining the client communication with the host vehicle to create a combined communication comprises a single document(i.e. the targeted advertisement is attached to the letter or parcel)(figure 1, step 13).

With respect to claim 46, Reiter further teaches wherein the inputting means comprising a bar code reader (col. 4, lines 50-62).

With respect to claim 51, is similar in scope as claims 1, 40, 42 and 50 and therefore rejected under similar rationale.

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With respect to claims 52 and 53, the claims differ from 1, 40, 42, 50 and 51 in that it further recites providing a format for the client communication wherein the communication format includes a variable portion(col. 7, lines 53-66).

With respect to claim 54 is similar in scope as claims 39 and 41 and therefore rejected under similar rationale.

With respect to claims 55 and 56 are similar in scope as claims 52 and 53 and therefore rejected under similar rationale.

With respect to claim 57, is similar in scope as claims 39, 41 and 54 and therefore rejected under similar rationale.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6, 9-12, 14-37 and 43-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reiter (5,819,241 and Reiter hereinafter) in view of Applicant's admitted prior art.

With respect to claim 6, Reiter teaches different variable client information(col. 7, lines 24-39). Reiter does not specifically teach that one of the variable information is the client's age. As admitted by the Applicant's admitted prior art on page 3, lines 14-19, companies

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such as Insurance companies would have pre-existing databases of client information for their clients such as the customer's age. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included the customer's age as one of the variable client information because such a modification would better target the advertisements because people's ages is important to determine the individual needs and desires.

With respect to claims 9-12 and 14, the claims further recite: the variable client information comprises client asset information. As admitted by the Applicant's prior art on page 2, lines 30-, page 3, lines 14-19, companies such as mortgage companies would have a pre-existing database with customers information, therefore it would be obvious to have a person's asset information in the mortgage companies database to enable the mortgage company to determine if the customer has sufficient property to pay their debts, as well as financial income information and client activity information. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included client asset information, financial income information and client activity information because such a modification would better target advertisements by specifying the individual's needs.

With respect to claim 15, the limitations were previously addressed in claims 6-14 and therefore is rejected under similar rationale.

With respect to claim 16, it further recites: the variable client information comprises at least one of psychographic and demographic client data. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included psychographic and

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demographic information into the client's communication because such a modification would address the statistical characteristics of the market population.

With respect to claims 17 and 18, the claims further recite: the variable financial product information pertains to a plurality of different financial products. As admitted by Applicant's prior on page 2, lines 12-15, financial advertisements of financial products and services is well known. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included the variable product information pertaining to a plurality of different financial products because such a modification would determine client needs with various financial products to select the best most appropriate one for the individual.

With respect to claims 19-21, the claims further recite: product information pertains to an individual term life insurance product. As admitted on Applicant's admitted prior art on page 3, lines 28-31, product information pertaining to term life insurance products are known in the prior art. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included financial product information pertaining to a term life insurance product because such a modification would allow the insurance companies to use the system to distribute advertisements.

With respect to claim 22, it further recites: individual life insurance product other than a term life insurance product. Life Insurance product consist of term life and whole life or Universal life insurance policies. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included information pertaining to other life

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insurance product such as Whole life or Universal life insurance products because such a modification would allow the Insurance companies to have more flexibility of the products that they can offer.

With respect to claims 23-25, the claims further recite: the variable product information pertains to a disability insurance product. Life insurance companies provide disability insurance product and annuity. Therefore it would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included the variable information pertaining to disability insurance and annuity products because such a modification would allow the insurance companies to use the system to advertise their various products according to the individual's information.

With respect to claims 26-30, the claims merely recite: the variable product information pertains to a savings product, investment product, financial security, loan product and an equity instrument, a debt instrument, a money market fund, and a mutual fund. Banks provide savings products, investment products, financial securities, loan products, equity instruments, debt instruments, money market funds and mutual funds. Therefore it would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included variable product information pertaining to savings products, investments products, financial securities, loan products, equity instruments, money market funds and mutual funds because such a modification would allow the Banks to use the system to target the individual needs.

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With respect to claims 31 and 32, the claims further recite: the variable information comprises product pricing information and non-price information. It is well known in the marketing and advertisement field to include product pricing information and non-price information such as a description of the product to inform the customer of the specifics of the products being offered. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included price and non-pricing information because such a modification would give the customer the abundant information to make a decision.

With respect to claims 33-36, the claims further recite: the variable information wherein the ancillary information comprises statistical demographic information, geo-code data, and psychographic information. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included ancillary information comprising of demographic information, geo-code data and psychographic data because such a modification would allow the advertising companies to better target their advertisements pertaining to the individuals needs.

With respect to claim 37, it differs from claim 33 in that it further recites: that the economic data pertains to one or more person. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included ancillary information comprising of economic data pertaining to more than one person because such a modification would allow the advertisements to be target to a group of people.

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With respect to claims 43-47, it further recites: that the inputting means comprises a disk drive, a tape drive, an optical scanner, a bar code reader, a modem. Reiter teaches that any suitable means of inputting data may be utilized such as bar code reader, an optical scanner(col. 4, lines 50-56). Reiter does not specifically teach that the inputting means comprises a disk drive, a tape drive and inputting means comprising modem. Disk drive, tape drives and inputting means comprising a modem are well known in the computer related arts for inputting information. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have used disk drive, tape drives and inputting means comprising a modem for alternative means of inputting the information into the system.

With respect to claims 48 and 49, the claims further recite: that the output preparing means comprises a modem and a laser printer. It is well known in the computer related arts to include a modem and a laser printer for preparing the output. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's to have used a laser printer and a modem because such a modification would speed up the output process.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

A. Lawlor et al. (5,220,501) disclosed a method and system for remote delivery of retail banking services;

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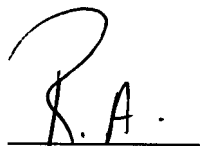
B. Muscoplat (5,640,835) disclosed a multiple envelope with integrally formed and printed and printed contents and return envelope;

C. Enrico disclosed a system of renting New York telephone listings to marketers.

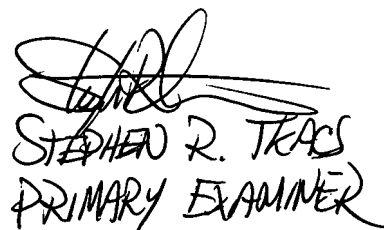
Points Of Contact

6. Any inquiry concerning this communications from the examiner should be directed to Raquel Alvarez whose telephone number is (703) 305-0456. The examiner can normally be reached on Monday to Friday from 9:00 AM. To 5:00 PM.

If any attempt to reach the examiner by telephone is unsuccessful, The examiner's supervisor, Emanuel Todd Voeltz can be reached on (703) 305-9714. The fax phone number for this group is (703) 305-9731.



Raquel Alvarez
Patent Examiner, AU 2761
October 22, 1998



STEPHEN R. TRACS
PRIMARY EXAMINER